IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of   :   Customer Number: 46320
                                        :
Yoshiko MIKAMI   :   Confirmation Number: 1909
                                        :
Application No.: 10/632,160   :   Group Art Unit: 2152
                                        :
Filed: July 31, 2003   :   Examiner: B. Whipple
                                        :
For: NETWORK SYSTEM ALLOWING THE SHARING OF USER PROFILE
       INFORMATION AMONG NETWORK USERS

APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Appeal Brief is submitted in support of the Notice of Appeal filed August 27, 2007, wherein Appellant appeals from the Examiner's rejection of claims 1-11.

I. REAL PARTY IN INTEREST

This application is assigned to IBM Corporation by assignment recorded on July 31, 2003, at Reel 014356, Frame 0854.

II. RELATED APPEALS AND INTERFERENCES

Appellant is unaware of any related appeals and interferences.

III. STATUS OF CLAIMS

Claims 1-11 are pending and finally rejected in this Application. Claims 12-18 have been cancelled. It is from the final rejection of claims 1-11 that this Appeal is taken.

IV. STATUS OF AMENDMENTS

The claims have not been amended subsequent to the imposition of the Second Office Action dated May 25, 2007 (hereinafter the Second Office Action).

V. SUMMARY OF CLAIMED SUBJECT MATTER

Referring to Figures 2, 5 and 10 and to independent claims 1 and 9, a method for use in a network system is disclosed. In S1004, S1005, host computer profile information relating to individual users of the host computer is stored, the profile information for a first user and a second user identifies host applications that the first user and the second user, respectively, are permitted to execute (paragraphs [0034], [0074] of Appellant's disclosure). In S1006, in response to a request from the first user identifying a list of one or more applications that the first user is permitted to execute, the list is stored in the profile of the second user, and the second user is permitted to execute the applications in the list under control of the first user (lines 9-15 of paragraph [0020]; paragraph [0035]; lines 6-14 of paragraph [0077]).

Referring to Figures 2, 5, and 10 and to independent claim 5, a host computer for use in a network system is disclosed. The host computer includes storing means 550 and responding to request means 560. The storing means 550 stores profile information relating to individual users of the host computer 230. The profile information is for a first user and a second user and identifies host applications that the first user and the second user, respectively, are permitted to

execute (paragraphs [0034], [0074]). The request to request means 560 responds to a request from the first user identifying a list of one or more applications that the first user is permitted to execute for storing the list in the profile of the second user. The second user is permitted to execute the applications in the list under control of the first user (lines 9-15 of paragraph [0020]; paragraph [0035]; lines 6-14 of paragraph [0077]).

VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

1. Claims 1-11 were rejected under 35 U.S.C. § 102 for anticipation based upon Gatz et al., U.S. Patent Publication No. 2002/0049806 (hereinafter Gatz).

VII. ARGUMENT

THE REJECTION OF CLAIMS 1-11 UNDER 35 U.S.C. § 102 FOR ANTICIPATION BASED UPON GATZ

For convenience of the Honorable Board in addressing the rejections, and claims 2-11 stand or fall together with independent claim 1.

On pages 6-9 of the First Response dated May 2, 2007, Appellant argued that the Examiner failed to clearly designate the teachings in Gatz being relied upon the statement of the rejection. Moreover, on page 9 of the First Response, Appellant requested that the Examiner specifically identify features corresponding to the claimed (i) a request identifying a list of one or more applications that a first user is permitted to execute; (ii) a first user; (iii) a second user; (iv) storing the list in the profile of the second user; and (iv) permitting the second user to execute the application in the list under control of the first user, as recited in claim 1.

Regarding limitation (i), the Examiner asserted the following on page 3 of the Second

Office Action:

> "A request identifying a list of one or more applications that a first user is permitted to execute" is disclosed, as cited in the original Office Action, by Gatz ([0073]; [0074], ln. 8-12; [0075]; a parent may request to view child accounts and set full, limited, or no access to the applications of an online account for a child such as chatting, buddy lists, website access, etc.; the parent, as the controlling member of the online account, <u>inherently has access to the applications being limited for other users</u> as the parent could not grant full access to other users if the parent did not have full access). (emphasis added)

Appellant respectfully submits that the Examiner's analysis is deficient.

Claim 1 recites "identifying a list of one or more applications that the first user is permitted to execute" and "the second user is permitted to execute the applications in the list under control of the first user." In the Examiner's cited passages, Gatz describes how a parent (i.e., allegedly disclosing the claimed first user) logs into a child account (i.e., allegedly disclosing the claimed second user) and is able to select/modify/control various aspects of the child account. <u>Completely absent</u> from these teachings, however, is a description of the "one or more applications that a [parent] is permitted to execute." Thus, Gatz fails to explicitly teach this limitation. Moreover, the list, as claimed, is of "one or more applications that the first user is permitted to execute." Assuming arguendo that Gatz discloses a list, such a list of the applications that the second user (i.e., the child) is permitted to execute.

Since Gatz does not explicitly teach this feature, the Examiner argued that "the parent, as the controlling member of the online account, inherently has access to the applications being limited for other users as the parent could not grant full access to other users if the parent did not have full access." In this regard, Appellant submits that the Examiner's reliance upon the doctrine of inherency to disclose this feature is misplaced. Inherency may not be established by

probabilities or possibilities. The mere fact that a certain thing <u>may</u> result from a given set of circumstances <u>is not sufficient</u> to establish inherency.[1] To establish inherency, the extrinsic evidence must make clear that the missing element must <u>necessarily be present</u> in the thing described in the reference, and that the necessity of the feature's presence would be so recognized by persons of ordinary skill.[2] Furthermore, reference is made to <u>ex parte Schricker</u>,[3] in which the Honorable Board of Patent Appeals and Interferences stated the following:

> However, when an examiner relies on inherency, it is incumbent on the examiner to point to the "page and line" of the prior art which justifies an inherency theory. <u>Compare</u>, <u>In re Rijckaert</u>, 9 F.3d 1531, 1533, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (when the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the prior art); <u>In re Yates</u>, 663 F.2d 1054, 107, 211 USPQ 1149, 1151 (CCPA 1981).

The Examiner did not discharge that burden of indicating where the parent inherently has access to the applications been limited for other users appears in the prior art. Appellant is unaware of any technical requirement for the parent to have access, for example, to receiving e-mail or instant messaging, for the parent to provide to allow/deny access to the child for these features. Moreover, <u>even if</u> the parents inherently had access to the applications, the parent (i.e., allegedly corresponding to the claimed first user) may not be permitted to use the application (e.g., the parent chooses not to have access to the application or the parent is required to sign up for application, in order to user the application, and the parent has not).

Thus, the Examiner has not established that this limitation is either explicitly or inherently disclosed by Gatz. Therefore, for the reasons stated above, Appellant respectfully

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[1] <u>In re Rijckaert</u>, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); <u>In re Oelrich</u>, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981).
[2] <u>Finnegan Corp. v. ITC</u>, 180 F.3d 1354, 51 USPQ2d 1001 (Fed. Cir. 1999); <u>In re Robertson</u>, 169 F.3d 743, 745 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999); <u>Continental Can Co. USA v. Monsanto Co.</u>, 20 USPQ 2d 1746 (Fed. Cir. 1991); <u>Ex parte Levy</u>, 17 USPQ2d 1461 (BPAI 1990).
[3] 56 USPQ2d 1723, 1725 (BPAI 2000).

submits that the Examiner has failed to establish that Gatz identically discloses the claimed invention, as recited in claims 1-11, within the meaning of 35 U.S.C. § 102.

Conclusion

Based upon the foregoing, Appellant respectfully submit that the Examiner's rejection under 35 U.S.C. § 102 based upon the applied prior art are not viable. Appellant, therefore, respectfully solicits the Honorable Board to reverse the Examiner's rejection under 35 U.S.C. § 102.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due under 37 C.F.R. §§ 1.17, 41.20, and in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: August 30, 2007   Respectfully submitted,

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VIII. CLAIMS APPENDIX

1. A method for use in a network system comprising:

storing at a host computer profile information relating to individual users of the host computer, the profile information for a first user and a second user identifying host applications that the first user and the second user, respectively, are permitted to execute,

in response to a request from the first user identifying a list of one or more applications that the first user is permitted to execute, storing the list in the profile of the second user, whereby the second user is permitted to execute the applications in the list under control of the first user.

2. The method of claim 1 wherein the host computer executes any version of the HTTP protocol.

3. The method of claim 1 or claim 2 wherein an application in the list when executed performs a service from the second user to the first user.

4. The method of claim 1 or claim 2 wherein the storing step further comprises storing in the profile of the second user attributes that affect the execution of an application in the list.

5. A host computer for use in a network system comprising:

means for storing profile information relating to individual users of the host computer, the profile information for a first user and a second user identifying host applications that the first user and the second user, respectively, are permitted to execute,

means responsive to a request from the first user identifying a list of one or more applications that the first user is permitted to execute for storing the list in the profile of the second user, whereby the second user is permitted to execute the applications in the list under control of the first user.

6. The host computer of claim 5 further comprising means for executing an HTTP protocol.

7. The host computer of claim 5 or claim 6 wherein an application in the list comprises means for performing a service from the second user to the first user.

8. The host computer of claim 5 or claim 6 wherein the storing means further comprises second means for storing in the profile of the second user attributes that affect the execution of an application in the list.

9. A computer product for storing a computer software program, which when loaded into a computer and executed, causes the computer to perform a method comprising:

storing at a host computer profile information relating to individual users of the host computer, the profile information for a first user and a second user identifying host applications that the first user and the second user, respectively, are permitted to execute,

in response to a request from the first user identifying a list of one or more applications that the first user is permitted to execute, storing the list in the profile of the second user, whereby the second user is permitted to execute the applications in the list under control of the first user.

10. The computer product of claim 9 wherein an application in the list when executed by the computer performs a service from the second user to the first user.

11. The computer product of claim 9 or claim 10 wherein the storing step further comprises storing in the profile of the second user attributes that affect the execution of an application in the list.

IX. EVIDENCE APPENDIX

No evidence submitted pursuant to 37 C.F.R. §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the Examiner has been relied upon by Appellant in this Appeal, and thus no evidence is attached hereto.

X. RELATED PROCEEDINGS APPENDIX

Since Appellant is unaware of any related appeals and interferences, no decision rendered by a court or the Board is attached hereto.